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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,216	10/09/2001	Edward H. Gilbert	018804.000004	7428
27643	7590	04/03/2007	EXAMINER	
THOMPSON & KNIGHT L.L.P. PATENT PROSECUTION DEPARTMENT 801 CHERRY ST., SUITE 1600 FORT WORTH, TX 76102			COBANOGLU, DILEK B	
			ART UNIT	PAPER NUMBER
			3626	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/03/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/973,216	GILBERT, EDWARD H.
	<b>Examiner</b>	<b>Art Unit</b>
	Dilek B. Cobanoglu	3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 October 2001.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-20 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

1. Claims 1-20 have been examined.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being unpatentable by McIlroy et al. (hereinafter McIlroy) (U.S. Patent No. 5,953,704).

A. As per claim 1, McIlroy discloses a method, comprising the steps of:

- i. receiving a test result variable code (McIlroy; abstract, col. 10, lines 9-19);
- ii. receiving a protocol choice corresponding to the test result variable code (McIlroy; col. 6, lines 13-17, col. 10, lines 9-19, Figure 9b);
- iii. receiving a treatment code (McIlroy; col. 12, lines 53-65, col. 13, lines 11-25);
- iv. determining whether the treatment code corresponds to the protocol choice (McIlroy; col. 5, lines 35-45); and

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- v. storing the test result variable code, protocol choice and treatment code (McIlroy; col. 4, lines 38-48, col. 12, lines 29-32).
- B. As per claim 2, McIlroy discloses the method of claim 1, further comprising the step of displaying a set of protocol choices corresponding to the test result variable code, from which the protocol choice may be selected (McIlroy; col. 5, lines 9-20).
- C. As per claim 3, McIlroy discloses the method of claim 1, further comprising the step of displaying a set of treatment codes corresponding to the protocol choice, from which the treatment code may be selected (McIlroy; col. 5, lines 9-20).
- D. As per claim 4, McIlroy discloses the method of claim 1, further comprising the step of displaying a warning if the treatment code does not correspond to the protocol choice (McIlroy; col. 13, lines 26-29).
- E. As per claim 5, McIlroy discloses the method of claim 1, further comprising the step of receiving a justification for at least one of the protocol choice and the treatment code (McIlroy; col. 5, lines 45-53).
- F. As per claim 6, McIlroy discloses the method of claim 1, wherein the test result variable code, protocol choice, and treatment code are stored in a data structure comprising:
  - i. a first code uniquely identifying a protocol grouping assigning priorities to one or more protocol choices based on a range of one or more

disease variable values (McIlroy; col. 4, line 62 to col. 5, line 8, col. 12, lines 53-65, Figure 16);

ii. a second code identifying a protocol choice selected from the protocol grouping and a justification for selecting the protocol choice (McIlroy; col. 12, lines 53-65, Figure 16);

iii. a third code identifying each procedure, diagnostic test, or treatment performed pursuant to the protocol choice and a justification for selecting each respective procedure, diagnostic test, or treatment (McIlroy; col. 13, lines 11-25); and

iv. a fourth code defining a charge code for all procedures, diagnostic tests, and treatments performed (McIlroy; col. 13, lines 26-38)..

G. As per claim 7, McIlroy discloses the method of claim 1, wherein the test result variable code, protocol choice and treatment code are analyzed for cost accounting and to determine clinical appropriateness (McIlroy; col. 8, lines 45-64).

H. As per claims 8-14, they are system claims, which repeat the same limitations of claims 1-7, the corresponding method claims, as a collection of elements as opposed to a series of process steps. Since the teachings of McIlroy disclose the underlying process steps that constitute the methods of claims 1-7, it is respectfully submitted that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claims 8-14 are rejected for the same reasons given above for claims 1-7.

I. As per claims 15-20, it is an article of manufacture claim which repeats the same limitations of claim 1-7, the corresponding method claim, as a collection of executable instructions stored on machine readable media as opposed to a series of process steps. Since the teachings of McIlroy disclose the underlying process steps that constitute the method of claim 1-7, it is respectfully submitted that they likewise disclose the executable instructions that perform the steps as well. As such, the limitations of claim 15-20, are rejected for the same reasons given above for claim 1-7.

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not used prior art teach Medical insurance verification and processing system 4491725 A, Electronically readable medical locking system 5272318 A, All care health management system 5301105 A, Computer-implemented method for profiling medical claims 5835897 A, System and method for recording patient-history data about on-going physician care procedures 5845253 A, Provider claim editing and settlement system 6341265 B1, Computer-implemented method for profiling medical claims 6370511 B1.
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.

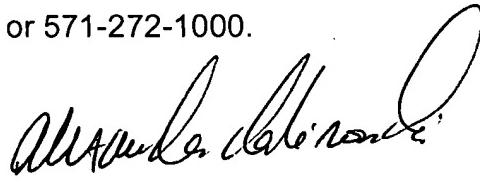
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6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DBC

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Art Unit 3626  
03/19/2007



ALEXANDER KALINOWSKI  
SUPERVISORY PATENT EXAMINER